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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,819	05/24/2001	Thomas W. Smith	82654	2387

7590 09/30/2004

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EXAMINER

QUELER, ADAM M

ART UNIT	PAPER NUMBER
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2179

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/864,819

Applicant(s)

SMITH, THOMAS W.

Examiner

Adam M Queler

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05/24/2001.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Application filed 5/24/2001, Preliminary Amendment and Formal Drawings filed 1/8/2002
2. Claims 1-12 are pending in the case. Claims 1 and 6 are independent claims.

Drawings

3. The drawings were received on 1/8/2002. These drawings are acceptable.

Specification

4. The use of the trademark "Microsoft VC++" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

5. **Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.**

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Microsoft VC++ is not mentioned at all in the specification.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

If the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 5 is evidence that the markup tool claimed in claims 1-5, are intended to be software per se, which is not tangibly embodied, and therefore non-statutory.

Claim Rejections - 35 USC § 102

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9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-2, 5-7, and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Microsoft Word 2000 (C) 1999, and attached help files, hereinafter Microsoft.

Regarding independent claim(s) 1 and 6, Microsoft teaches selecting and retrieving a document in a native format (“How to import...”, para. 1). Microsoft teaches changing the format by converting to Word, a common format (“How to import...”, para. 1). The document is then opened in Word (“How to import...”, para. 1), which inherently is used for reviewing and changing documents.

Regarding dependent claim(s) 2 and 7, Microsoft teaches opening and saving in the same format thereby reconvert and storing the document (“File format...” pp. 1-2).

Regarding dependent claim(s) 5, the language the tool is programmed in is not a patentably distinct limitation.

Regarding dependent claim(s) 10, Microsoft teaches pointing a mouse toward an area to be edited and pointing to the top left corner of that area (Screenshot 2). Microsoft teaches dragging the pointer to the bottom right area and providing a rectangle encompassing the area (Screenshot 3). Although not shown the mouse is inherently released. Microsoft teaches providing a dialog to allow user to enter alterations (Screenshot. 4). Microsoft teaches entering alterations (Screenshots 5-6).

Regarding dependent claim(s) 11, due to the black and white pictures it is not explicitly shown, but when selecting white on yellow text, Microsoft teaches that the rectangles is blue (Screenshot 3)

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft as applied to claims 1 and 6 above, and further in view of "What Is A Zip File, Anyhow?" archived 2/29/2000,**

(<http://web.archive.org/web/20000229130845/www.winzip.com/aboutzip.htm>), hereinafter WinZip.

Regarding dependent claim(s) 3 and 8, Microsoft does not explicitly disclose compression. WinZip teaches compressing data (p. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine WinZip and Microsoft; thereby compressing the data after it has been changed to a common format, in order to save disk space (WinZip, p. 1, bullet 3).

13. **Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft as applied to claims 1 and 6 above, and further in view of Biemesderfer, "Graphics Inclusions in Manuscripts" found at**

<http://www.sunspot.noao.edu/general/computing/TeX/local/postscript/> (6/7/1996).

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Regarding dependent claim(s) 4 and 9, Microsoft does not use Postscript has its common format. Biemesderfer teaches Postscript as a common format (p.2, section 1). It would have been obvious to replace the Word format of Microsoft with the Postscript of Biemesderfer because it is device independent and suitable for interchange (Biemesderfer, p. 2, section 1).

Allowable Subject Matter

14. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach nor is there any reason to suggest a selection rectangle including dashed X's or checks.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US-6,704,906 B1 to Yankovich et al.

US-5,867,112 A to Kost, James F.

US-6,119,137 A to Smith et al.

US-6,151,289 A to Rope et al.

US-6,357,006 B1 to Pham et al.

US-6,380,924 B1 to Yee et al.

US-2002/0035731 A1 to Plotnick et al.

US-6,009,442 A to Chen et al.

Microsoft(R) Product Support Services Application Note (Text File) WD0910: FILE CONVERSIONS
QUESTIONS AND ANSWERS, Revision date 10/93, found at
<http://files.chatnfiles.com/The%20Pier%20Shareware%204/047/WD0910.ZIP>

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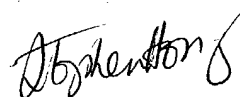
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (703) 308-5213.

The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ



STEPHEN S. HONG
PRIMARY EXAMINER